

### **Remarks**

Applicant would like to thank the Office for entering the Applicant's Request for Continued Examination along with the accompanying amendment and response dated April 21, 2008.

Claims 1 and 3-14 were pending in this application, one or more have been rejected. Applicant is pleased to note that claim 14 has been deemed allowable. By way of this amendment, claims 1, 4, 5, 9 and 11 have been amended to more fully claim the subject invention. Support for the claims amendments can be found in the originally filed specification, claims and drawings. *No new matter has been added.*

The foregoing amendments were made solely in an effort to expedite prosecution and allowance of the present application. The applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

Accordingly, upon the entry of the present amendment and response, claims 1 and 3-14 will remain pending.

### **Rejection Under 35 USC § 112, Second Paragraph**

Claims 1 and 3-13 have been rejected under 35 USC § 112, second paragraph, as allegedly being indefinite on the ground that "[t]he recitation reads (1) the bore in which the valve slides discharges to an external surface portion of a reception head and this discharging causes the valve in translation. This recitation brings in several new elements such as a new external surface portion of a new reception head other than what is previously recited in the claim, and a bore that is opening on to the new external surface portion. It is unclear how these structures are related. It is also unclear what drives the valve in translation." *See* page 2 of Office Action mailed May 12, 2008.

Applicant respectfully traverses this rejection. Applicant notes that it is clear from the Federal Circuit legal precedent that, claim language must be analyzed, not in a vacuum, but in light of the content of the particular application disclosure. Applicant submits that based on the plain language of the claims in light of the teachings in Applicant's specification as originally filed and the drawings, it would have been abundantly clear to one of ordinary skill in the art as to how the various structural elements of the claimed device are related to each other.

Nonetheless, without acquiescing to the validity of this rejection and solely in an effort to expedite prosecution and allowance of the instant claims, independent claims 1 and 11 have been amended to further define the interrelatedness of the various structural elements. Specifically, claim 1, as amended, now further recites a reception head including a reception surface and an external surface portion and also clarifies that the head support includes a driver device adapted to bear against the valve to drive it in

translation into a first position or a second position. Also, claim 11, as amended recites a reception head including a reception surface.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of this rejection.

### **Rejections Under 35 USC § 102/103**

#### **I. Claims 1-3 and 8**

The rejection of claims 1-3 and 8 as allegedly being anticipated under 35 USC §102(e) by, or in the alternative, under 35 USC §103(a) as being obvious over U.S. Patent No. 6,884,341, in the name of Ferguson (hereinafter referred to as "*Ferguson*") has been maintained on the ground that the pressure sensitive check valve in figure 3a-b and vent 214 with valve 213 in figure 2b-c in *Ferguson* is an equivalent to the claimed valve means. See page 3 of Office Action mailed May 12, 2008.

Applicant respectfully traverses this rejection. For a prior art reference to anticipate a claimed invention under 35 U.S.C. §102, the prior art reference must teach ***each and every limitation*** of the claimed invention. See, *Lewmar Marine v. Barient* 827 F.2d 744, 3 USPQ2d 1766 (Fed. Cir. 1987). Applicant submits that *Ferguson* fails to teach or suggest each and every limitation of the claimed invention at least for the reasons enunciated in Applicant's responses filed on November 27, 2007 and April 21, 2008, as well as discussed *infra*.

Further, a proper *prima facie* obviousness rejection requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Additionally, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. §2143. Also, see *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1443 (Fed. Cir. 1991) (the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure).

Applicant also notes that in a recent case, *KSR International Co. v. Teleflex Inc. et al.* (127 S. Ct. 1727 (2007)), the Supreme Court stated that "[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

It appears that the Office has maintained this rejection on the ground that the pressure valve disclosed in *Ferguson* is equivalent to the selectively operable closure means. Applicant notes that consistent with the legal principle enunciated by the Supreme Court in *KSR*, the Office has failed to provide a reason which would have

prompted one of ordinary skill in the relevant art to conclude that the pressure sensor check valve of *Ferguson* is an equivalent of the valve of the claimed invention, as explained in detail *infra*.

As Applicant had previously pointed out, the valve included in the mechanical support of the claimed invention is not an equivalent of the pressure sensitive valve of the device disclosed in *Ferguson*. For example, in contrast to the valve in the device of *Ferguson* which is responsive to pressure, the claimed valve does not respond to pressure. Accordingly, the valve in the device of *Ferguson* cannot be an equivalent of the valve in the claimed device.

In fact, notably, the pressure sensitive check valve in the device of *Ferguson* is different both in structure as well as function from the claimed selectively operable means. Specifically, not only does the pressure sensitive check valve of *Ferguson* fail to include the claimed structure, *i.e.*, a valve adapted to slide in a bore, but the valve in the device of *Ferguson* is used for a completely different function, *i.e.*, ***monitoring the flow rate of liquid through the membrane versus for removing the trapped air***, as in case of the claimed invention.

Nonetheless, without acquiescing to the validity of this rejection and solely in an effort to expedite prosecution and allowance of the pending claims, Applicant has amended claim 1 to specify that the valve in the mechanical support of the claimed invention is operated from outside the reception head. Such a valve is used to open the passage, both when the filter unit is mounted and removed, in order ***to let the air trapped between the membrane and the reception surface to escape***, thereby to prevent deterioration of the membrane.

Accordingly, based on the teachings of *Ferguson*, one of ordinary skill in the art would not have been motivated to replace the pressure sensitive check valve in *Ferguson* with the valve in the claimed device as the valve in the claimed device is designed to perform a completely different function and does not yield the same result as the valve in the device of *Ferguson*.

In view of the foregoing, Applicant submits that *Ferguson* fails to teach, disclose or suggest the claimed mechanical support of the instant invention or any equivalents thereof, and accordingly, requests reconsideration and withdrawal of this rejection.

## II. Claims 1-6, 8-10, 11 and 13

Claims 1-6 and 8-10 have been rejected as allegedly being anticipated under 35 USC §102(b) by, or in the alternative, under 35 USC §103(a) as being obvious over U.S. Patent No. 6,027,638, in the name of Johnson (hereinafter referred to as "*Johnson*"). Additionally, claims 11 and 13 have been rejected as allegedly being obvious over *Johnson*.

Applicant respectfully traverses this rejection.

Applicant submits that like *Ferguson*, *Johnson* also fails to disclose a mechanical support for a filter unit or a reception head which includes ***a valve adapted to slide in a bore which discharges onto an external surface portion of a reception head and which is operated from the outside***. Instead, the valves in the device of *Johnson* are ***opened and closed by vacuum***. The vacuum opens the valves in the device of *Johnson*, ***thereby to aspirate the sample***. In contrast, in case of the claimed invention, the valve is ***operated from outside the head*** which is used to open the passage, both when the filter unit is mounted and removed, in order ***to let the air trapped between the membrane and the reception surface to escape***, thereby to prevent deterioration of the membrane.

In view of the foregoing, Applicant submits that the claimed invention is both novel as well as obvious over *Johnson* and, accordingly, requests reconsideration and withdrawal of this rejection.

**Conclusion**

In view of the foregoing amendments and arguments, allowance of the instant application with all pending claims is respectfully solicited. If a telephonic conversation with Applicant's attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned at the number below. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 13-3577.

Respectfully submitted



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